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GROUP 3600

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/318,447
Filing Date: May 25, 1999
Appellant(s): HARTMAN ET AL.

David T. Dutcher
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/17/2006 appealing from the Office action

mailed 10/7/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

The examiner is only aware of proceedings that have been identified in the appeal brief.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,819,034	Joseph et al	10-1998
5,815,665	Teper et al	09-1998
5,893,076	Hafner et al	4-1999
5,960,411	Hartman et al	9-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 108-123,126-137,151-156,159-163 and 176-183 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 5,960,441 in view of Hafner (55,893,076). The claims of Patent "411" teach placing single action orders over an electronic network and the other claimed features of the instant application, but does not specifically mention that the orders are combined or that a log in is required before server level information can be changed by the customer.

Hafner teaches a method and system for consolidating orders from multiple orders (col 8, lines 1-28 and col 10, lines 20-30). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in the claims of "441" the consolidation capability as taught by Hafner, because this would facilitate increased optimization by better controlling inventory and shipping costs. The combination of "441" and Hafner teaches consolidating orders, but does not specifically mention all the time intervals and availability items of the instant claims. The examiner takes Official Notice that it was old and well known in the art at the time of the invention to place time intervals on processing time and combining deliveries/orders based on availability. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in the combination of "441"/Hefner placing time intervals on processing time and combining deliveries/orders based on availability, because this would assure that the orders are processed in a timely manner and would also allow orders to be combined in a manner that is optimized.

Further, the combination of "441" and Hefner does not teach a log in required to change account information of the user. The examiner takes Official Notice that it was old and well known in the art at the time of the invention to have a remote storage site containing personal information authenticate users before information could be changed. It would have been obvious to a person having ordinary skill in the art at the

time of the invention to include the coordination by the server of changes to stored
personal data, because authenticating the user would assure that only the user that
provided the information could change it, therefore, creating more security of personal
information and preventing others from stealing or manipulating the otherwise secure
data.

Claim Rejections - 35 USC § 103
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

**Claims 108-117,151-156, and 176-183 are rejected under 35 U.S.C. 103(a) as
being unpatentable over Joseph et al (5,819,034) in view of Teper et al (5,815,665)
and further in view of Official Notice.**

In regards to claim 108, Joseph discloses a method in a client system for
ordering an item, the method comprising:
Joseph teaches receiving information from a server system (col 7, lines 33-37)
and storing information persistently for transmittal to a server system (col 8, lines 52-
60), but does not specifically mention that the information saved in persistent storage
that is received from the server system is an identifier. Teper teaches providing a
unique identifier to a user for later identifying a user and mapping to a remote site where
personal information of the user is kept (see summary). It would have been obvious to a
person having ordinary skill in the art to include in Joseph storing an identifier which
authorizes the use of personal information stored on a server as taught by Teper,
because this would free up storage space on the client computer by storing information
and programming on the server while still maintaining control of the data at the local
client computer. This additional storage capacity could be used to increase the
processing efficiency of the other programs that are running on the client.
when an item is to be ordered, displaying information identifying the item (col 8,
lines 23-33) and
The combination of Joseph/Teper teaches performing a single action to process
an order by pressing a button and having instructions displayed interactively (col 8, lines
14-67), but does not specifically mention displaying an indication that a single action is
to be performed. It was old and well known in the art at the time of the invention to
include instructions such as a display of an indication of a button to press to impose an
executable action on a web page. The examiner takes Official Notice that it would have
been obvious to a person having ordinary skill in the art to include in Joseph/Teper the

displayed indication of what button to press to activate the order, because this would assure that the correct button was pushed to complete the order, thus reducing the frustration of the user by making the system easier to use. and

in response to the single action being performed, sending to the server system a request to order the identified item along with the client identifier (see discussion above concerning storage of an identifier and the appendage of client information with the purchase data, col 8, line 52- col 9, line 8) ,

the client identifier identifying account information previously supplied by a user of the client system wherein the user does not need to log in to the server system when ordering the item (Per discussion above the combination of Joseph/Teper teach appending a stored identifier to gain access to personal information to automatically access stored account information thus eliminating the need to input the authorization each time the server is accessed); and

The combination of Joseph/Teper teach accessing a server, registering and providing personalized data which is later accessed (Teper col 6, lines 4-13), but does not specifically mention that the server system coordinates changes to the stored data. The examiner takes Official Notice that it was old and well known in the art at the time of the invention to have a remote storage site containing personal information authenticate users before information could be changed. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include the coordination by the server of changes to stored personal data, because authenticating the user would assure that only the user that provided the information could change it, therefore, creating more security of personal information and preventing others from stealing or manipulating the otherwise secure data.

receiving updated account information (col 6, lines 4-13); and

sending the updated account information to the server system whereby the user does not need to log in to the server system when ordering the item, but needs to log in to the server system when changing previously supplied account information (see discussion above).

In regards to claim 109, Joseph teaches wherein the account information includes billing information (Teper col 6, lines 4-13).

In regards to claim 110, Joseph teaches wherein the account information includes shipping information (Teper col 6, lines 4-13).

In regards to claim 111, Joseph teaches wherein the client system and server system communicate via the Internet (Joseph, FIG 1 and Teper col 5, lines 17-32).

In regards to claim 112, Joseph teaches receiving from the server system a confirmation that the order was generated (col 8, lines 50 and 51).

In regards to claim 113, the combination of Joseph/Teper teaches inputting information (col 7, lines 10-15), but does not specifically mention that the inputting of the

information is accomplished by clicking a mouse button when a cursor is positioned over a predefined area of the displayed information. The examiner takes Official Notice that clicking a mouse button when a cursor is positioned over a predefined area of the displayed information was old and well known at the time of the invention. It would have been obvious to a person having ordinary skill in the art to include in the combination of Joseph/Teper clicking a mouse button when a cursor is positioned over a predefined area of the displayed information, because this would provide an efficient means for inputting information and provide additional functionality to make the system more user friendly.

In regards to claim 114, The examiner takes Official Notice that displaying partial information to protect the users personal information was old and well known in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art to include in the combination of Joseph/Teper, providing partial information, because providing only partial information has notoriously been known to protect the users identity and personal information from theft.

In regards to claim 115, The examiner takes Official Notice that displaying partial information to protect the users personal information was old and well known in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art to include in the combination of Joseph/Teper, providing partial information, because providing only partial information has notoriously been known to protect the users identity and personal information from theft.

In regards to claim 116, the examiner takes Official Notice that displaying partial information to protect the users personal information was old and well known in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art to include in the combination of Joseph/Teper, providing partial information, because providing only partial information has notoriously been known to protect the users identity and personal information from theft.

In regards to claim 117, Joseph teaches wherein the item may alternatively be ordered using a shopping cart model. First, applicant's specification page 6, lines 23-26 purports, shopping cart technology is an admitted conventional system, the disclosure further purports, page 6, line 26 – page 7, line 1, that selectively including or excluding an alternative would be obvious. The examiner therefore also takes Official Notice that the use of shopping carts for electronic commerce was old and well known at the time of the invention. It would have been obvious to a person having ordinary skill in the art to include in Joseph/Teper the use of an alternative to one click shopping such as a shopping cart, because users may feel uncomfortable accomplishing the transaction without having the opportunity to review the transaction before submittal, therefore including this alternative would increase the usage of the site by offering a shopping cart model to those who prefer using the conventional technology.

In regards to claim 151, Joseph teaches a client system for ordering an item, comprising:

a component that receives from a server system a client identifier of the client system and that stores the client identifier persistently;

a component that orders an item by displaying information identifying the item along with an indication of a single action that is to be performed to order the identified item and by sending to the server system a request to order the identified item along with the client identifier,

the client identifier identifying account information previously supplied by a user wherein the user does not need to log in to the server system when ordering the item; and

a component that updates account information by coordinating the log in of the user to the server system, receiving updated account information from the user, and sending the updated account information to the server system (see response to claim 108).

In regards to claim 152, Joseph teaches wherein the account information includes billing information (Teper col 6, lines 4-13).

In regards to claim 153, Joseph teaches wherein the account information includes shipping information (Teper col 6, lines 4-13).

In regards to claim 154, the combination of Joseph/Teper teaches inputting information (col 7, lines 10-15), but does not specifically mention that the inputting of the information is accomplished by clicking a mouse button when a cursor is positioned over a predefined area of the displayed information. The examiner takes Official Notice that clicking a mouse button when a cursor is positioned over a predefined area of the displayed information was old and well known at the time of the invention. It would have been obvious to a person having ordinary skill in the art to include in the combination of Joseph/Teper clicking a mouse button when a cursor is positioned over a predefined area of the displayed information, because this would provide an efficient means for inputting information and provide additional functionality to make the system more user friendly.

In regards to claim 155, Joseph teaches wherein the item may alternatively be ordered using a shopping cart model. First, applicant's specification page 6, lines 23-26 purports, shopping cart technology is an admitted conventional system, the disclosure further purports, page 6, line 26 – page 7, line 1, that selectively including or excluding an alternative would be obvious. The examiner therefore also takes Official Notice that the use of shopping carts for electronic commerce was old and well known at the time of the invention. It would have been obvious to a person having ordinary skill in the art to include in Joseph/Teper the use of an alternative to one click shopping such as a

shopping cart, because users may feel uncomfortable accomplishing the transaction without having the opportunity to review the transaction before submittal, therefore including this alternative would increase the usage of the site by offering a shopping cart model to those who prefer using the conventional technology.

In regards to claim 156, Joseph teaches wherein the server system combines multiple requests to order items into a single order (see response to claim 151, what is known as common functionality in a shopping cart model).

In regards to claim 176, Joseph discloses a method in a computer for ordering an item, the method comprising:
    providing to a client system a client identifier for the client system,
    the client identifier being associated with account information of a user and for persistent storage at the client system;
    when an item is to be ordered, providing to the client system a display page identifying an item,
    the display page including an indication of a single action that is to be performed to order the identified item;
    receiving from the client system an indication that the user performed the single action along with the client identifier; and
    generating an order for the identified item using the account information associated with the received client identifier wherein the user does not need to log in to the computer system to order the item; and
    when account information is to be changed, coordinating the log in of the user to the computer system;
    receiving from the client system updated account information; and
    updating the account information associated with the client identifier of the logged in user based on the received updated account information (see response to claim 108).

In regards to claim 177, Joseph teaches wherein the account information includes billing information (Teper col 6, lines 4-13).

In regards to claim 178, Joseph teaches wherein the account information includes shipping information (Teper col 6, lines 4-13).

In regards to claim 179, Joseph teaches wherein the client system and server system communicate via the Internet (Joseph, FIG 1 and Teper col 5, lines 17-32).

In regards to claim 180, the combination of Joseph/Teper teaches inputting information (col 7, lines 10-15), but does not specifically mention that the inputting of the information is accomplished by clicking a mouse button when a cursor is positioned

over a predefined area of the displayed information. The examiner takes Official Notice that clicking a mouse button when a cursor is positioned over a predefined area of the displayed information was old and well known at the time of the invention. It would have been obvious to a person having ordinary skill in the art to include in the combination of Joseph/Teper clicking a mouse button when a cursor is positioned over a predefined area of the displayed information, because this would provide an efficient means for inputting information and provide additional functionality to make the system more user friendly.

In regards to claim 181, The examiner takes official Notice that displaying partial information to protect the users personal information was old and well known in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art to include in the combination of Joseph/Teper, providing partial information, because providing only partial information has notoriously been known to protect the users identity and personal information from theft.

In regards to claim 182, the examiner takes Official Notice that displaying partial information to protect the users personal information was old and well known in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art to include in the combination of Joseph/Teper, providing partial information, because providing only partial information has notoriously been known to protect the users identity and personal information from theft.

In regards to claim 183, applicant's specification page 6, lines 23-26 purports, shopping cart technology is an admitted conventional system, the disclosure further purports, page 6, line 26 – page 7, line 1, that selectively including or excluding an alternative would be obvious. The examiner therefore also takes Official Notice that the use of shopping carts for electronic commerce was old and well known at the time of the invention. It would have been obvious to a person having ordinary skill in the art to include in Joseph/Teper the use of an alternative to one click shopping such as a shopping cart, because users may feel uncomfortable accomplishing the transaction without having the opportunity to review the transaction before submittal, therefore including this alternative would increase the usage of the site by offering a shopping cart model to those who prefer using the conventional technology.

Claims 118-123,126-137, and 159-163 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph et al (5,819,034) in view of Teper et al (5,815,665) in view of Official Notice and further in view of Hafner et al (5,893,076).

In regards to claims 118-123, 127-131, and 159-163 the combination of Joseph/Teper teaches placing single action orders over an electronic network, but does not specifically mention that the orders are combined. Hafner teaches a method and system for consolidating orders from multiple orders (col 8, lines 1-28 and col 10, lines

20-30). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Joseph/Teper the consolidation capability as taught by Hafner, because this would facilitate increased optimization by better controlling inventory and shipping costs. The combination of Joseph/Teper/Hafner teaches consolidating orders, but does not specifically mention all the time intervals and availability items of the instant claims. First, the examiner notes that the applicant's disclosure states that "one skilled in the art would appreciate that the single action orders can be combined in various ways based on other factors, such as size of shipment and intermediate-term availability" (page 12, lines 9-12). Likewise, the examiner takes Official Notice that it was old and well known in the art at the time of the invention to place time intervals on processing time and combining deliveries/orders based on availability. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in the combination of Joseph/Teper/Hafner placing time intervals on processing time and combining deliveries/orders based on availability, because this would assure that the orders are processed in a timely manner and would also allow orders to be combined in a manner that is optimized.

In regards to claim 126, Joseph discloses a method in a client system for ordering items, the method comprising:
receiving from a server system a client identifier of the client system; persistently storing the client identifier at the client system; and
for each of a plurality of items displaying information identifying the item and displaying an indication of a single action that is to be performed to order the identified item; and
in response to the single action being performed, sending to the server system a request to order the identified item and the client identifier, the client identifier identifying account information of a user wherein the server computer automatically combines orders into a single order (see response to claim 108).

In regards to claim 132, Joseph teaches wherein the client system and server system communicate via the Internet (Joseph, FIG 1 and Teper col 5, lines 17-32).

In regards to claim 133, the combination of Joseph/Teper teaches inputting information (col 7, lines 10-15), but does not specifically mention that the inputting of the information is accomplished by clicking a mouse button when a cursor is positioned over a predefined area of the displayed information. The examiner takes Official Notice that clicking a mouse button when a cursor is positioned over a predefined area of the displayed information was old and well known at the time of the invention. It would have been obvious to a person having ordinary skill in the art to include in the combination of Joseph/Teper clicking a mouse button when a cursor is positioned over a predefined area of the displayed information, because this would provide an efficient means for inputting information and provide additional functionality to make the system more user friendly.

In regards to claim 134, the examiner takes Official Notice that displaying partial information to protect the users personal information was old and well known in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art to include in the combination of Joseph/Teper, providing partial information, because providing only partial information has notoriously been known to protect the users identity and personal information from theft.

In regards to claim 135, the examiner takes Official Notice that displaying partial information to protect the users personal information was old and well known in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art to include in the combination of Joseph/Teper, providing partial information, because providing only partial information has notoriously been known to protect the users identity and personal information from theft.

In regards to claim 136, the examiner takes Official Notice that displaying partial information to protect the users personal information was old and well known in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art to include in the combination of Joseph/Teper, providing partial information, because providing only partial information has notoriously been known to protect the users identity and personal information from theft.

In regards to claim 137, Joseph teaches wherein the item may alternatively be ordered using a shopping cart model. First, applicant's specification page 6, lines 23-26 purports, shopping cart technology is an admitted conventional system, the disclosure further purports, page 6, line 26 – page 7, line 1, that selectively including or excluding an alternative would be obvious. The examiner therefore also takes Official Notice that the use of shopping carts for electronic commerce was old and well known at the time of the invention. It would have been obvious to a person having ordinary skill in the art to include in Joseph/Teper the use of an alternative to one click shopping such as a shopping cart, because users may feel uncomfortable accomplishing the transaction without having the opportunity to review the transaction before submittal, therefore including this alternative would increase the usage of the site by offering a shopping cart model to those who prefer using the conventional technology.

(10) Response to Argument

The following are responses to appellant's arguments:

Obviousness-Type Double Patent Rejection

VIA1 – The examiner concurs with appellant that the proper reference was Hafner and not Webber.

VIIA1a – Appellant argues that "the examiner has failed to adequately address the limitation of the claims that do not require a user to log in when ordering an item, but require a user to log in when changing account information". The examiner disagrees and points out that the log in feature is for updating a database that holds the information that will be used once the client ID is sent to the server (FIG 3), the ordering of the items without a login is separate in that one feature is not dependent on the other in the processing of the transaction. Therefore, the claims of patent "441" clearly do not require a log in to make a purchase since a client ID is sent to authenticate the client computer (fig 3). Fig's 8A-8C show how information is gathered at a website to be used for later processing of the order. As noted in the previous office action the claims of the "411" patent are silent on the use of a log-in to enter the site to update the information, however since this is a separate operation motivation is only required for the additional step of why one would be motivated to require log in during the entering of personal data at a website.

Further, appellant has not traversed the examiner's use of Official Notice
that requiring a login during updating of personal information in a server is old
and well known in the art. A "traverse" is a denial of an opposing party's
allegations of fact. The Examiner respectfully submits that applicants'
arguments and comments do not appear to traverse what Examiner regards as
knowledge that would have been generally available to one of ordinary skill in
the art at the time the invention was made. Even if one were to interpret
applicants' arguments and comments as constituting a traverse, applicants'
arguments and comments do not appear to constitute an <u>adequate traverse</u>
because applicant has not specifically pointed out the supposed errors in the
examiner's action, which would include stating why the noticed fact is not
considered to be common knowledge or well-known in the art. 27 CFR
1.104(d)(2), MPEP 707.07(a). An <u>adequate</u> traverse must contain adequate
information or argument to create on its face a reasonable doubt regarding the
circumstances justifying Examiner's notice of what is well known to one of
ordinary skill in the art. <u>In re Boon</u>, 439 F.2d 724, 728, 169 USPQ 231, 234
(CCPA1971).

If applicant does not seasonably traverse the well-known statement during
examination, then the object of the well-known statement is taken to be admitted prior
art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

VIIA1b. – Appellant argues that "the examiner has failed to address the

"automatically" combining difference between Hafner and the claims". The examiner

disagrees and directs the appellant's attention to col 2, lines 30-40 where the supplier

modifies (consolidates) the order without the need for retailer input. Secondly the

supplier is clearly using a computerized processor for automatic modification

(consolidation) of the orders (col 2, lines 49-54). It is clear that the objective of Hafner is

to automate the consolidation of the orders as is suggested in col 2, line 23-25).

In response to applicant's argument that there is no suggestion to combine the

references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, applicant argues

the rationale of the motivation arguing 1) that inventory costs will increase, the examiner

disagrees and suggests that the products being pulled at the same time save the cost of

an inventory control person removing the products from inventory individually 2)

appellant eludes that Hafner consolidates all orders, this is simply not true as each

combination is separately considered (col 2, lines 15-60) 3) appellant suggest that

combining orders does not control shipping costs, the examiner disagrees and provides

as an example the following situation: Five orders are placed for two products from the

same retailer, clearly combining all five orders (if available) in one shipment would be less expensive than shipping each order individually.

Further, even if Hafner did not teach an automation of the consolidation and only a manual equivalent as is purported by the appellant It would have been obvious to one of ordinary skill in the art at the time of the invention was made to make the process of automating the consolidation, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. In re Venner, 120 USPQ 192.

VIIA1c. – Appellant argues that "the suggested motivating benefit of assuring that orders are processed in a timely manner does not result from the suggested combination.

Appellant argues the examiner "inexplicable use of applicant's discloser to reject the claim feature. The examiner acquiesces and removes this argument from consideration by the board.

The appellant states that they do not understand what it means "to place time intervals on processing time". What the examiner thought was clear was that "to place time intervals on processing time" referred to is appellant's claims where time intervals are claimed such as claims 119,120,127,128,159,160 and that the processing time is that time which is allotted to process the order i.e. 90 minutes. The applicant further does not understand how waiting for a time interval to elapse would assure that an

order would be processed in a timely manner. The examiner directs the appellant's

attention to Hafner for an example of this situation where a suggested business

transaction, that includes a schedule, is used to create the combination of orders (col 2,

lines 58-60. Clearly it is understood that should a business indefinitely hold orders

waiting for the next order to arrive the business would quickly go out of business, since

the business will never process an order. On the other hand if different orders are

consolidated and the time interval is not indefinite than a time interval must be present.

VIIA1d. – Appellant argues that "the examiner's suggested motivating benefit of

allowing orders to be combined in a manner that is optimized does not necessarily lead

to the suggested combination".

Appellant once again does not understand what the examiner is taking

official notice of based on the phrase "combining deliveries/orders based on

availability". The examiner believes that it was abundantly clear that the examiner

was referring to claims 121, 122,123,129,130,131,161,162 and 163, since all

these claims contain the subject matter term availability. The examiner

disagrees that availability of products for delivery and combining orders are "very

different concepts" as stated by the appellant. The examiner directs the

appellant's attention to the "411" col 7, lines 25-55, where appellant makes a

direct correlation between shipments and deliveries, therefore, the examiner

contends that if an order could not be delivered in say one day it would not be

combined with another order that could be delivered the same day. This would apply likewise to varying time frames such as long, short and intermediate.

Further, appellant has not traversed the examiner's use of Official Notice that combining orders based on availability was old and well known in the art. A "traverse" is a denial of an opposing party's allegations of fact. The Examiner respectfully submits that applicants' arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an <u>adequate traverse</u> because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An <u>adequate</u> traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. <u>In re Boon</u>, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well-known statement during examination, then the object of the well-known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

Lastly, in addressing the appellant's assertion that optimizing would not be a benefit of combining orders for delivery, the examiner states that combining orders would minimize costs and optimize the grouping of orders. For example, the multiple orders would be picked at one time saving the cost of picking and packing and orders that could be shipped within a reasonable time period could be optimized by placing all the items in one box saving both shipping and packaging costs.

Obviousness Rejections Of The Claims On The Merits Joseph in view of Teper

VIIB2a – Applicant argues that "Joseph and Teper fail to disclose or suggest not requiring a user to log in when ordering an item, but requiring a log in when changing account information".

First - In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Second – in response to appellant's argument that the combination does teach the login, no login nuance of the instant claims. The examiner disagrees and notes for instance that the two acts of logging in and not logging in are separate operations; one not necessarily being dependent on the other. For instance, the entering of information

that will be used to complete the transaction is entered in to the system at an earlier

date, so that the user will not need to reenter the information continuously. This feature

being taught by both Joseph and Teper.

Appellant suggests that the references cannot be combined because Joseph

stores the information on the client side. The examiner disagrees and states that this is

precisely the improvement taught by Teper, that being that the storage of information at

a remote site is effective in keeping personal information safe by not sending this

information each time an order is made.

Appellant argues that Teper requires that the user manually enter a password

each time before a purchase can be made. The examiner disagrees and directs the

applicant's attention to col 3, lines 50-53 of Teper, where the password is stored on the

client side so that the password need not be reentered.

Appellant argues that that there is no motivation within the reference to combine

the arrive at the result of the no login, login combination. Obviously the motivation for no

login is present in each reference; Joseph, to maintain a one click option and Teper, to

resolve the issue of having to reenter the password (Teper col 3, lines 50-53). And

relating to the login requirement, Teper states throughout the specification that

protecting personal information is paramount to the invention (see at least col 4, lines

30-35).

VIIB2b – Appellant argues that "Joseph and Teper fail to disclose or suggest

receiving from a server system a client identifier of the client system, persistently storing

the client identifier at the client system and, when an item is to be ordered, sending to

the server system a request to order the identified item along with the client identifier".

Appellant argues that the combination does not teach an identifier is persistently

stored at the client side computer, the examiner disagrees and directs the appellants

attention to Teper col 3, lines 1-21.

The appellant argues that the motivation used by the examiner, storing

information on a server would save storage space, is not factual, pointing out that it

would require even more space. The examiner does not understand this conclusion

when it clearly takes less space to store an identifier, than it would to store all the

personal information and the software to populate the pages of and webpage order

form.

Appellant further argues that there is no motivation present in the cited

references. The examiner disagrees and directs the appellant's attention to the many

statements in Teper to support the protection of personal information (see at least col 4,

lines 30-35).

VIIB2c – Appellant argues that "Hafner fails to disclose or suggest automatically

combining multiple orders into a single order" pointing out that each order needs to be

approved. The examiner disagrees and directs the appellant's attention to col 1, lines

60-65, col 2, lines 23-25 and col 2, lines 37-38). Additionally the appellant is reminded it

has been held that broadly providing an automatic means to replace manual activity

which has accomplished the same result involves only routine skill in the art. In Re

Venner, 120 USPQ 192.

Appellant further argues that the examiner inexplicably relies on

applicant's own disclosure to address the features claim 127 "the requested

orders are combined when sent within a certain time interval" and claim 129 "the

requested orders are combined when the requested items have similar

availability". The examiner acquiesces and removes this argument from

consideration by the board. However, the Official Notice rejection is maintained

and appellant is reminded that a "traverse" is a denial of an opposing party's

allegations of fact. The Examiner respectfully submits that applicants'

arguments and comments do not appear to traverse what Examiner regards as

knowledge that would have been generally available to one of ordinary skill in

the art at the time the invention was made. Even if one were to interpret

applicants' arguments and comments as constituting a traverse, applicants'

arguments and comments do not appear to constitute an adequate traverse

because applicant has not specifically pointed out the supposed errors in the

examiner's action, which would include stating why the noticed fact is not

considered to be common knowledge or well-known in the art. 27 CFR

1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate

information or argument to create on its face a reasonable doubt regarding the

circumstances justifying Examiner's notice of what is well known to one of

ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234

(CCPA1971).

If applicant does not seasonably traverse the well-known statement during

examination, then the object of the well-known statement is taken to be admitted prior

art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

VIIB3a – Appellant argues the rejection of claims 108-117,151-155, and 176-183.

In response the examiner directs the appellant's attention to section **VIIB2a and VIIB2b**

VIIB3b - Appellant argues in regards to claim 156 that the combination of Joseph

and Teper does not teach combining "multiple requests to order items into a single

order". In response the examiner directs the appellant's attention to section **VIIB2c**

**Obviousness Rejections Of The Claims On The Merits Joseph in view of
Teper in view of Hafner and further in view of Official Notice**

VIIB4a – In regards to claim 118 applicant argues that the combination of Joseph

and Teper does not teach combining "multiple requests to order items into a single

order". The examiner disagrees and directs the appellant's attention to the response to

claim 156 above item **VIIB3b.**

VIIB4b – Appellant argues with regards to claims 119 and 120 that the combination does not teach "sent within a certain interval" or "within 90 minutes", then refers back to section 2c for the reasoned arguments. The examiner disagrees and refers the appellant back to the response to claims 127 and 129 above item **VIIB2c**.

VIIB4c – Appellant argues in regards to claims 121-123 the combination does not teach "the identified item in an order with another item with similar availability". The examiner disagrees and directs the appellant's attention to the response to **VIIB4b** above.

VIIB4d – Appellant argues in regards to claims 126 and 132-137 that the combination fails to teach "receiving from a server system a client identifier of the client of the client system; persistently storing the client identifier at the client system" and "in response to the single action being performed, performing, sending to the server a request to order the identified item and the client identifier". The appellant refers back to section 2,b for reasoned argument. The examiner disagrees and directs the appellant to the response to **VIIB2b** above.

VIIB4e – Appellant argues with regards to claims 127-128 that the combination does not teach "sent within a certain interval" or "within 90 minutes", then refers back to section 2c for the reasoned arguments. The examiner disagrees and refers the appellant back to the response to claims 127 and 129 above item **VIIB2c**.

VIIB4f - Appellant argues in regards to claims 129-131 that the combination does not teach "the identified item in an order with another item with similar availability". The examiner disagrees and directs the appellant's attention to the response to **VIIB4b** above.

VIIB4g - Appellant argues in regards to claims 158-160 that the combination does not teach "wherein the requested orders are combined into a single order when received within a certain time interval ". The appellant further argues that "providing to the client system a client identifier for the system, the client identifier being associated with account information of a user and for persistent storage at the client system" and "receiving from the client system a request to order the identified an item, the request including the client identifier". The examiner disagrees and directs the appellant's attention to the response **VIIB2c and VIIB2b** above.

VIIB4h - Appellant argues in regards to claims 158, 161-163 that the combination does not teach "wherein the requested orders are combined into a single order when received within a certain time interval ". The appellant further argues that "providing to the client system a client identifier for the system, the client identifier being associated with account information of a user and for persistent storage at the client system" and "receiving from the client system a request to order the identified an item, the request

including the client identifier". The examiner disagrees and directs the appellant's

attention to the response **VIIB2c and VIIB2b** above.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and

Interferences section of the appeal brief has provided therewith.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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September 15, 2006

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